

REMARKS

Claims 1-20 were pending in this application.

Claims 1-20 have been rejected.

Claims 1, 2, 5, and 6 have been amended as shown above.

Claims 21-23 have been added.

Claims 1-23 are now pending in this application.

Reconsideration and full allowance of Claims 1-23 are respectfully requested.

I. REJECTION UNDER 35 U.S.C. § 102

The Office Action rejects Claims 1, 2, 5, 6, 10, 16, and 17 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,237,417 to Hayashi (“*Hayashi*”). This rejection is respectfully traversed.

A prior art reference anticipates a claimed invention under 35 U.S.C. § 102 only if every element of the claimed invention is identically shown in that single reference, arranged as they are in the claims. (*MPEP* § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990)). Anticipation is only shown where each and every limitation of the claimed invention is found in a single prior art reference. (*MPEP* § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985)).

Regarding Claim 1, *Hayashi* recites a television receiver that displays “control data” in a subsidiary screen area 16 so that the control data does not obstruct a main screen area 15. (*Abstract*;

Figure 4). The control data identifies parameters (such as “Hue” and “Brightness”) and includes control bars 17 showing the current settings for those parameters. (*Figure 4; Col. 4, Lines 30-43*). A user uses a remote control or other mechanism to select one of the parameters and adjust the setting of that parameter, and the control bar 17 for that parameter and the images in the main screen area 15 are updated with the new setting. (*Col. 5, Lines 49-64*).

First, nothing here indicates that the television receiver of *Hayashi* is capable of adjusting one of its parameters based on a “current ambient factor” and/or a “property of [the] signals” as recited in Claim 1. *Hayashi* simply recites that a user may adjust various parameters for a television receiver. The user may select the parameter and increase or decrease the current level of that parameter. A control bar 17 is updated to reflect the new setting, and the new setting is used to process the images displayed in the main screen area 15. In other words, the parameters in *Hayashi* are only adjusted by a user, not using a “current ambient factor” and/or a “property” of the signals being received. As a result, *Hayashi* fails to anticipate “parameter control means” adapted to “compute adjustments to [a] parameter” based on a “current ambient factor” and/or a “property of [the] signals” as recited in Claim 1.

Second, each control bar 17 of *Hayashi* only identifies the current setting for one of the parameters, where the current setting may be adjusted by a user. When the user adjusts a parameter setting, the control bar 17 for that setting is updated. In other words, each control bar 17 only represents the user-selected setting for a particular parameter. None of the control bars 17 in *Hayashi* identifies “computed adjustments” to a parameter, where the computed adjustments are

based on both (i) a “preferred parameter level for the parameter” and (ii) a “current ambient factor” and/or a “property of [the] signals” as recited in Claim 1.

For these reasons, *Hayashi* fails to anticipate the Applicant’s invention as recited in Claim 1 (and its dependent claims). For similar reasons, *Hayashi* fails to anticipate the Applicant’s invention as recited in Claim 5 (and its dependent claims).

Accordingly, the Applicant respectfully requests withdrawal of the § 102 rejection and full allowance of Claims 1, 2, 5, 6, 10, 16, and 17.

II. REJECTION UNDER 35 U.S.C. § 103

The Office Action rejects Claims 1-20 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,411,306 to Miller et al. (“*Miller*”) in view of *Hayashi*. This rejection is respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. (*MPEP* § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992)). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. (*MPEP* § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984)). Only when a *prima facie* case of obviousness is established does the burden shift to the Applicant to produce evidence of nonobviousness. (*MPEP* § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re*

Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993)). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the Applicant is entitled to grant of a patent. (*In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985)).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. (*In re Bell*, 991 F.2d 781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993)). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on the Applicant's disclosure. (MPEP § 2142).

Miller recites an apparatus and method that dynamically modify the luminance and contrast of a displayed image in response to changing lighting conditions. (*Abstract*). The apparatus stores various default values, such as a default illuminance value and a default surround luminance value. (*Col. 5, Lines 20-23*). Actual illuminance and surround luminance values are measured by sensors are compared to the default values, and the luminance and contrast are adjusted using the actual measurements if the actual measurements differ from the default values. (*Col. 5, Lines 23-60*).

The Office Action acknowledges that *Miller* fails to disclose an “indicator means” for presenting a “level indicator which is indicative of said computed adjustments” as recited in Claim 1. (*Office Action, Page 5, Third paragraph*). The Office Action relies on *Hayashi* as disclosing these elements of Claim 1. (*Office Action, Page 5, Last paragraph*).

As shown above, *Hayashi* only discloses presenting control bars 17 to users, where the control bars 17 identify the user-specified settings for parameters. *Hayashi* lacks any mention of presenting both a “first level indicator” that is indicative of “computed adjustments” to a parameter and a “second level indicator” that is indicative of a “preferred parameter level” as recited in Claim 1.

None of the cited references disclose, teach, or suggest using a “level indicator” to identify “computed adjustments” to a parameter. At most, the proposed *Miller-Hayashi* combination would suggest allowing a user in *Miller* to select a setting for a parameter using a control bar 17 of *Hayashi*. The proposed *Miller-Hayashi* combination would not include a second control bar that is indicative of “computed adjustments” to a parameter as recited in Claim 1. As a result, the proposed *Miller-Hayashi* combination fails to disclose, teach, or suggest all elements recited in Claim 1.

For these reasons, the Office Action has not established a *prima facie* case of obviousness against Claim 1 (and its dependent claims). For similar reasons, the Office Action has not established a *prima facie* case of obviousness against Claim 5 (and its dependent claims).

Accordingly, the Applicant respectfully requests withdrawal of the § 103 rejection and full allowance of Claims 1-20.

III. NEW CLAIMS

The Applicant has added new Claims 21-23. The Applicant respectfully submits that no new matter has been added. The Applicants respectfully request entry and full allowance of Claims 21-23.

IV. CONCLUSION

The Applicant respectfully asserts that all pending claims in this application are in condition for allowance and respectfully requests full allowance of the claims.

SUMMARY

If any issues arise, or if the Examiner has any suggestions for expediting allowance of this application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *wmunck@davismunck.com*.

The Applicant has included the appropriate fee to cover the cost of this AMENDMENT AND RESPONSE. The Commissioner is hereby authorized to charge any additional fees connected with this communication (including any extension of time fees) or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

DAVIS MUNCK, P.C.

Date:

May 9, 2005



William A. Munck
Registration No. 39,308

P.O. Drawer 800889
Dallas, Texas 75380
(972) 628-3600 (main number)
(972) 628-3616 (fax)
E-mail: *wmunck@davismunck.com*